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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,037	01/22/2004	Robert J. Schwartz	HO-P02659US1	8488
26271 7590 05/28/2009 FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095				
EXAMINER				
LONG, SCOTT				
ART UNIT		PAPER NUMBER		
1633				
MAIL DATE		DELIVERY MODE		
05/28/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Interview Summary

**Application No.**

10/763,037

**Applicant(s)**

SCHWARTZ ET AL.

**Examiner**

SCOTT LONG

**Art Unit**

1633

All participants (applicant, applicant's representative, PTO personnel):

(1) SCOTT LONG.

(3) Ling Chwang; Amy Olfers (Applicant Reps.).

(2) Janet Epps-Smith (Primary Examiner).

(4) Joseph Weitach (SPE).

Date of Interview: 07 March 2009.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal (copy given to: 1) ☐ applicant 2) ☐ applicant's representative

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.  
If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: 5.

Identification of prior art discussed: Narula and Drewett.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

/SCOTT LONG/  
Examiner, Art Unit 1633

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

#### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

#### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

The Applicant's Representatives (Olfers & Chwang), Examiners (Epps-Smith & Long) and Supervisory Patent Examiner Waitach discussed the Advisory Action (filed 1/16/2009), the merits of the 103 rejections and proposed general claim amendments to address the rejections of record and possible 112 1st issues.

The Applicant's Representatives indicated that they feel the Advisory Action did not properly address the merits of their arguments regarding the post-KSR judicial decisions which address biotech applications where KSR reasoning was applied in a rejection. In particular, the Applicant's Representative cited the following cases:

Ortho-McNeil Pharm., Inc. v. Caraco Pharm. Labs., Ltd., 476 F.3d 1321, 1326, 81 USPQ2d 1427, 1432 (Fed. Cir. 2007)

Eisai co. Ltd. v. Dr. Reddy's Laboratories Ltd., 87 U.S.P.Q.2d 1452 (Fed. Cir. 2008)

The examiner notes that the Ortho-McNeil case is not related to a rejection under 35 USC 103(a), but rather to infringement. Facts of this case do not relate to the pending rejection and the examiner is not sure why the applicant's representatives cited the case in their After Final arguments. In regards to the Eisai case, the obviousness rejection was based upon "structural similarity between claimed and prior art subject matter, where the prior art gives reason or motivation to make the claimed compounds." The fact pattern of the instant case is different; the difference of opinion between the examiner and applicants is not an argument about structural similarity.

At the beginning of the interview, once the Applicant's representatives had stated that they wished to make of record their view that the Examiner's Advisory Action was incomplete, SPE Waitach suggested that the Applicant's representatives indicate during the ensuing discussion how the Ortho-McNeil and Eisai fact patterns applied to the pending obviousness rejection. Following this invitation, there proceeded a thorough discussion of the rejection and various perspectives about the specific teachings of each of the cited references. In particular, it was discussed that apoptosis was known to occur in heart diseases such as cardiomyopathy, and was triggered by caspases 3, 7 and 8. Secondary references were provided to demonstrate that cleavage products of SRF could be produced. Moreover, the specification and the art of record in submitted IDSs clearly teach that SRF is present in cardiac tissue. Applicant's arguments focused on picking SRF from all the known apoptosis genes without a clear guidance that it is related to cardiac disease-specific apoptosis-related genes would not be obvious.

To advance prosecution and address the rejections of record, SPE Waitach recommended that the applicant make of record evidence that SRF cleavage is not involved in all apoptotic pathways in various tissues, and is involved in non-apoptotic related pathways in cardiac tissue that might teach away from the instantly claimed invention, so as to suggest that SRF cleavage would not be an obvious choice in methods of diagnosing cardiac disease through identifying evidence of apoptosis.

Applicants agreed to discuss the issues raised during the interview and file an RCE.

There was no agreement reached, regarding allowable subject matter.

/SCOTT LONG/  
patent examiner  
art unit 1633